

Appl. No. 09/839,544
Reply Dated April 30, 2003
Reply to Office action of Dec. 10, 2002

REMARKS

Applicant respectfully submits that the claims of her patent application, as amended, are allowable. Applicant has canceled claims 3, 12, and 14 as being drawn to embodiments no longer of interest. Furthermore, applicant respectfully submits that none of the references cited by the Examiner teach or suggest the limitation of returning modified particles to the body. The applicant has amended the claims to include this limitation in the two independent claims of the subject application. Grounds for this amendment may be found, for example, in the claims as originally filed. The limitations of "means for returning said analyzed and labeled particles to said living body" and "means for returning said modified and labeled particles to said living body" appear in claims 3 and 12, as originally filed. These limitations have been moved to independent claims 1 and 10 respectively. Redundant claims 3, 12, and 13 were then canceled. Claim 4 was amended to avoid dependency upon a canceled claim. Reconsideration is respectfully requested.

I. REJECTION OF CLAIMS 5-9 AS INDEFINITE

The Examiner has rejected claims 5-9 under 35 U.S.C. 112, second paragraph, as indefinite. The Examiner noted that claim 5 is dependent upon itself. Claims 6-9 are dependent, either directly or indirectly, from claim 5, and as such, are also indefinite. The applicant has amended claim 5 to correct the typographical error.

II. REJECTION OF CLAIMS 1-5, 9-14 BASED ON LEARY AND DAVIDNER

The Examiner has rejected claims 1-5, and 9-14 under 35 U.S.C. 103(a) in view of United States Patent 5,804,143 to Leary et al in further view of United States Patent 6,193,681 to

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Davidner et al. It is respectfully submitted that this rejection is untenable in that the Leary et al and/or Davidner et al references are deficient for one or more of the following reasons:

1. It is improper to combine the cited references for lack of a motivation or suggestion to combine.
2. The combination of the cited references does not produce the invention, as described in the amended claims.

Each of these reasons is discussed in more detail in the remainder of this response.

It is respectfully submitted that it is improper to combine the Leary et al and Davidner et al references in the manner suggested by the Examiner for lack of a suggestion or motivation to combine. As is disclosed in section 2143 of the M.P.E.P:

“...there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.”

The Examiner has asserted that Leary et al discloses a cell labeling and sorting device.

The Examiner has also asserted that Davidner et al discloses a cell treating, maintaining, and returning device. The applicant respectfully asserts that neither the Leary et al nor the Davidner et al references contain a suggestion or motivation to combine these two devices. The only motivation for the combination of such devices is the Examiner’s impermissible hindsight.

If the Examiner disagrees with the applicant’s assertion, applicant respectfully requests the Examiner to specifically point out those portions of the cited references that would suggest to those skilled in the art the modifications deemed to be “obvious” by Examiner. Applicant respectfully submits that, if the Examiner cannot provide such specific disclosures and suggestions in the prior art, the Examiner should withdraw his rejection of the claims.

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Even if the cited references provided one skilled in the art some impetus to combine them in the manner suggested by the Examiner, the 35 U.S.C. 103 rejection made by the Examiner still must fail in that they still do not produce applicant's claimed device. The applicant respectfully submits that neither the Leary et al or Davidner et al references teaches of returning modified particles to a living body.

As stated in the M.P.E.P. § 2143.03;

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. "

The Examiner has asserted that the Davidner et al reference teaches a device that "detects, separates, and treats toxic cells, returning good blood to the patient." Applicant respectfully submits that it is the *good blood*, and not the *modified particles*, which Davidner et al returns to the living body. As Stated in Column 5, Line 28 of the Davidner et al reference "The material filtered from the blood is collected in a filtrate collection reservoir 109..." and is not returned to the living body. This is clearly distinguishable from the instant invention, wherein the modified particles are returned to the living body. To more clearly define the applicant's invention, claims 1, 3, 4, 10, 12, and 13 have been amended. The limitation of 'means for returning particles to said living body' has been moved from dependent claims 3 and 12 to independent claims 1 and 10. The previous dependent claims were then canceled. Claim 13 was canceled as being drawn to a now redundant embodiment. Claim 4 has been amended to avoid dependency upon a canceled claim.

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III. REJECTION OF CLAIMS 6-8 BASED ON LEARY, DAVIDNER, AND DEKA.

The Examiner has rejected claims 6-8 under 35 U.S.C. 103(a) in view of United States Patent 5,804,143 to Leary et al in view of United States Patent 6,193,681 to Davidner et al in further view of United States Patent 6,197,593 to Deka et al. It is respectfully submitted that this rejection is untenable in that the Leary et al, Davidner et al, and/or Deka et al references are deficient for one or more of the following reasons:

1. It is improper to combine the cited references for lack of a motivation or suggestion to combine.
2. Claims 6-8 are drawn to a dependent claim of an allowable independent claim.

Each of these reasons is discussed in more detail in the remainder of this response.

It is respectfully submitted that it is improper to combine the Leary et al, Davidner et al, and Deka et al references in the manner suggested by the Examiner for lack of a suggestion or motivation to combine, as required by M.P.E.P. § 2143:

The Examiner has asserted that Leary et al discloses a cell labeling and sorting device. The Examiner has also asserted that Davidner et al teaches a cell treating, maintaining, and returning device. The Examiner now asserts that Deka et al discloses the use of a membrane-permeant red-excited dye to distinguish between cell types. The applicant respectfully asserts that neither the Leary et al, the Davidner et al, or the Deka et al references contain a suggestion or motivation to combine these three devices. The only motivation for the combination of such devices is the Examiner's impermissible hindsight.

If the Examiner disagrees with the applicant's assertion, applicant respectfully requests the Examiner to specifically point out those portions of the cited references that would suggest to

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those skilled in the art the modifications deemed to be "obvious" by Examiner. Applicant respectfully submits that, if the Examiner cannot provide such specific disclosures and suggestions in the prior art, the Examiner should withdraw his rejection of the claims.

Even if it were assumed, for the sake of argument, that there was a suggestion or motivation to combine the cited references, the rejection would still fail, as claims 6-8 are dependent claims of an allowable independent claim. As stated in the M.P.E.P. § 2143.03;

"If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious."

Additional reference may also be had to, e.g., *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

IV. REJECTION OF CLAIMS 15, 17-18 BASED ON LEARY, DAVIDNER, AND CROWLEY.

The Examiner has rejected claims 15, 17-18 under 35 U.S.C. 103(a) in view of United States Patent 5,804,143 to Leary et al in view of United States Patent 6,193,681 to Davidner et al in further view of United States Patent 6,119,031 to Crowley. It is respectfully submitted that this rejection is untenable in that the Leary et al, Davidner et al, and/or Crowley references are deficient for one or more of the following reasons:

1. It is improper to combine the cited references for lack of a motivation or suggestion to combine.
2. Claims 15, 17-18 are drawn to a dependent claim of an allowable independent claim.

Each of these reasons is discussed in more detail in the remainder of this response.

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It is respectfully submitted that it is improper to combine the Leary et al, Davidner et al, and Crowley references in the manner suggested by the Examiner for lack of a suggestion or motivation to combine, as required by M.P.E.P. § 2143:

The Examiner has asserted that Leary et al discloses a cell labeling and sorting device. The Examiner has also asserted that Davidner et al teaches a cell treating, maintaining, and returning device. The Examiner now asserts that Crowley discloses an implantable spectrophotometer. The applicant respectfully asserts that neither the Leary et al, the Davidner et al, or the Crowley references contain a suggestion or motivation to combine these three devices. The only motivation for the combination of such devices is the Examiner's impermissible hindsight.

If the Examiner disagrees with the applicant's assertion, applicant respectfully requests the Examiner to specifically point out those portions of the cited references that would suggest to those skilled in the art the modifications deemed to be "obvious" by Examiner. Applicant respectfully submits that, if the Examiner cannot provide such specific disclosures and suggestions in the prior art, the Examiner should withdraw his rejection of the claims.

Even if it were assumed, for the sake of argument, that there was a suggestion or motivation to combine the cited references, the rejection would still fail, as claims 15, 17-18 are dependent claims of an allowable independent claim, as required by M.P.E.P. § 2143.03.

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**V. REJECTION OF CLAIM 16 BASED ON LEARY, DAVIDNER, CROWLEY, AND
ABRAMS.**

The Examiner has rejected claim 16 under 35 U.S.C. 103(a) in view of United States Patent 5,804,143 to Leary et al in view of United States Patent 6,193,681 to Davidner et al in further view of United States Patent 6,119,031 to Crowley in further view of United States Patent 6,142,146 to Abrams et al. It is respectfully submitted that this rejection is untenable in that the Leary et al, Davidner et al, Crowley, and/or Abrams et al references are deficient for one or more of the following reasons:

1. It is improper to combine the cited references for lack of a motivation or suggestion to combine.
2. Claim 16 is drawn to a dependent claim of an allowable independent claim.

Each of these reasons is discussed in more detail in the remainder of this response.

It is respectfully submitted that it is improper to combine the Leary et al, Davidner et al, Crowley, and Abrams et al references in the manner suggested by the Examiner for lack of a suggestion or motivation to combine, as required by M.P.E.P. § 2143:

The Examiner has asserted that Leary et al discloses a cell labeling and sorting device. The Examiner has also asserted that Davidner et al teaches a cell treating, maintaining, and returning device. The Examiner has asserted that Crowley discloses an implantable spectrophotometer. The Examiner now asserts that Abrams et al teaches a means for producing electrical power upon the actuation of a pump. The applicant respectfully asserts that the Leary et al, the Davidner et al, the Crowley, nor the Abrams et al references contain a suggestion or

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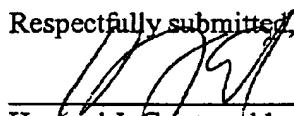
motivation to combine these four devices. The only motivation for the combination of such devices is the Examiner's impermissible hindsight.

If the Examiner disagrees with the applicant's assertion, applicant respectfully requests the Examiner to specifically point out those portions of the cited references that would suggest to those skilled in the art the modifications deemed to be "obvious" by Examiner. Applicant respectfully submits that, if the Examiner cannot provide such specific disclosures and suggestions in the prior art, the Examiner should withdraw his rejection of the claim.

Even if it were assumed, for the sake of argument, that there was a suggestion or motivation to combine the cited references, the rejection would still fail, as claim 16 is a dependent claim of an allowable independent claim, as required by M.P.E.P. § 2143.03.

It is respectfully submitted that all claims of the instant application are clearly allowable. If, for any reason, the Patent Examiner believes that a telephone conference with applicant's counsel might in any way facilitate the prosecution of this case, he is respectfully requested to call such counsel.

Respectfully submitted,


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